

REMARKS/ARGUMENTS

The Office Action mailed December 22, 2003, has been received and reviewed. Claims 3 through 5 and 8 through 10 are currently pending in the application. Claims 3 through 5 and 8 through 10 stand rejected. Applicants have amended claims 3, 5, 8 and 10, and respectfully request reconsideration of the application as amended herein.

35 U.S.C. § 112 Claim Rejections

Claims 5 and 10 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse this rejection, as hereinafter set forth. Specifically, the Office Action alleges that

[t]he limitation “the capacitor includes a first node and a second node, one node comprising a poly layer and the other node comprising a channel” recited in claims 5 and 10 is not disclosed in the specification to enable on skilled in the art to make and /or use the invention. Without this information it would take undue experimentation to make and use the claimed invention. (Office Action p. 2).

Applicants have amended claims 5 and 10 to more particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the term “one node” has been amended to recite “one of the first and second nodes”. Applicants respectfully assert that Applicants’ FIGS. 4-8, and the corresponding description, describe “wherein the on-chip capacitor includes a first node and a second node, one of the first and second nodes comprising a poly layer and the other one of the first and second nodes comprising a channel”, as claimed by Applicants. Therefore, undue experimentation would not be required as alleged by the Office Action. Applicants respectfully request the rejections be withdrawn.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 4,533,846 to Simko

Claims 3 through 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Simko (U.S. Patent No. 4,533,846). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants submit that the Simko reference does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of amended independent claim 3 because the Simko reference does not describe, either expressly or inherently, the identical inventions in as complete details as are contained in the claims. More specifically, Applicants submit that the Simko reference does not describe, either expressly or inherently, the elements of the claimed inventions of presently amended independent claim 3 calling for

A semiconductor device for operable connection to a carrier substrate, the semiconductor device comprising:
a regulator circuit . . . ;
a semiconductor substrate;
active circuit devices on the semiconductor substrate; and
an on-chip capacitor . . . , the on-chip capacitor being operably coupled in a shunt configuration to the regulator circuit and operably coupled in a shunt configuration to the active circuit devices to provide filtering capacitance for the semiconductor device. (Emphasis added.)

In contrast to the elements of the presently claimed inventions of amended independent claim 3 as set forth herein, the Simko reference only describes “a capacitive coupling means [which] will be an integrated circuit capacitor . . . , one plate of which makes electrical connection to the high potential input means, and the other plate of which makes electrical connection to the gate of the MOS clamp current regulating transistor.” (Col. 3, lines 8-16). Clearly, Simko’s configuration, as described and illustrated with reference to Simko’s FIGS. 1 and 2, is not arranged in a “shunt configuration” but is rather arranged in a “by pass configuration” as known by those of ordinary skill in the art. Applicants submit that such a configuration does not and cannot describe the presently claimed elements of the inventions of amended independent claim 3 under 35 U.S.C. § 102.

Therefore, presently amended independent claim 3 is not anticipated by the Simko reference under 35 U.S.C. § 102. Accordingly, such claim, and claims 4 and 5 depending therefrom, are allowable over the cited prior art.

Anticipation Rejection Based on U.S. Patent No. 4,533,846 to Simko

Claims 8 through 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Simko (U.S. Patent No. 4,533,846). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants submit that the Simko reference does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of amended independent claim 8 because the Simko reference does not describe, either expressly or inherently, the identical inventions in as complete details as are contained in the claims. More specifically, Applicants submit that the Simko reference does not describe, either expressly or inherently, the elements of the claimed inventions of presently amended independent claim 8 calling for

A semiconductor device for connection to a carrier substrate configured to provide power and ground thereto, the semiconductor device comprising:
a semiconductor substrate having active circuit elements formed on an active area thereof;
at least one regulator circuit . . .; and
at least one capacitor . . ., the at least one capacitor being operably coupled in a shunt configuration to the at least one regulator circuit and to the active circuit elements to provide filtering capacitance for the active circuit elements when the semiconductor device is operably connected to power and ground of the carrier substrate. (Emphasis added).

In contrast to the elements of the presently claimed inventions of amended independent claim 8 as set forth herein, the Simko reference only describes “a capacitive coupling means

[which] will be an integrated circuit capacitor . . . , one plate of which makes electrical connection to the high potential input means, and the other plate of which makes electrical connection to the gate of the MOS clamp current regulating transistor.” (Col. 3, lines 8-16). Clearly, Simko’s configuration, as described and illustrated with reference to Simko’s FIGS. 1 and 2, is not arranged in a “shunt configuration” but is rather arranged in a “by pass configuration” as known by those of ordinary skill in the art. Applicants submit that such a configuration does not and cannot describe the presently claimed elements of the inventions of amended independent claim 8 under 35 U.S.C. § 102.

Therefore, presently amended independent claim 8 is not anticipated by the Simko reference under 35 U.S.C. § 102. Accordingly, such claim, and claims 9 and 10 depending therefrom, are allowable over the cited prior art.

ENTRY OF AMENDMENTS

The amendments to claims 3, 5, 8 and 10 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

CONCLUSION

Claims 3-5 and 8-10 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



Kevin K. Johanson
Registration No. 38,506
Attorney for Applicant(s)
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

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